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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/531,630	04/14/2005	Kevin L. Hodge	18030-PCTUS	8412
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Lewis J. Kreisler Legal Department 930 Clopper Road Gaithersburg, MD 20878				
			EXAMINER CARR, DEBORAH D	
			ART UNIT 1621	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Supplemental
Office Action Summary

Application No.

10/531,630

Applicant(s)

HODGE ET AL.

Examiner

Deborah D. Carr

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6-19, 22 and 24-41 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 6-19, 22 and 24-41 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____.

- 4) ☒ Interview Summary (PTO-413)
Paper No(s)/Mail Date 2007 1002
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____.

DETAILED ACTION

Double Patenting

1. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

2. Claims 6-19, 22-41 provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-33 of copending Application No. 11/841,489. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double

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patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 19, 22, 26 provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-5 & claims 1, 6-7, 9-10, 15, 22-23 of copending Application Nos. 11/844,431 & 11/844,432 respectfully. Although the conflicting claims are not identical, they are not patentably distinct from each other because all three applications read on compounds of the same base structure, which can be used to treat metabolic disorders. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 6, 10-14, 18-19, 27, 32-34, 39-41 rejected under 35 U.S.C. 102(b) as being clearly anticipated by Haigh (US Pat. 5,589, 492).

US'492 teaches heterocyclic compounds and their use in the treatment of type -2 diabetes. The compounds can be used in a pharmaceutical composition and administered in unit dosage form in the range of 0.1 to 1000 mg. Applicable compounds that read on the instant invention are shown in procedures 1, 4-5 (cols. 31-33) and claims 1-2, 4, 8-9, 11-12.

Claim Rejections - 35 USC § 102/103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 6-19, 22, 24-41 rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Tajima et al. (WO-99/11255).

WO'255 anticipated the instant invention by teaching heterocyclic or (un) substituted carbocyclic compounds and their use in the treatment of diabetes, obesity, hyperlipemia, and

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arteriosclerosis. The compounds can be used in a pharmaceutical composition and administered in unit dosage form within the instant range.

The claims differ from the reference by stating specific substitutions on the substituted carbocyclic compound such as "2,6-dimethylphenyl." However it is stated the carbocyclic compound (i.e. phenyl;) can be substituted with up to four 1-8 alkyl groups.

Therefore to modify the substituted carbocyclic (i.e., phenyl) with 2 methyl groups at the 2nd & 6th position on the phenyl would have been within the skill of one of ordinary skill in the art.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

10. Claims 6-19, 22, 24-41 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for reducing blood glucose, triglycerides and fatty acids level in diabetic mice using the compounds listed in claims 9, 17, 22, 30, 37, does not reasonably provide enablement for treating all of the diseases listed in claim 6, 13-14, 34, 41 using any of these compounds. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

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The factors to be considered in determining whether a disclosure meets the enablement requirement of 35 USC 112, first paragraph, have been described in *In re Wands*, 8 USPQ2d 1400 (Fed. Cir. 1988). Among these factors are: the nature of the invention; the state of the prior art; the relative skill of those in the art; the predictability or unpredictability of the art; the breadth of the claims; the amount of direction or guidance presented; the presence or absence of working examples; and the quantity of experimentation necessary. When the above factors are weighed, it is the examiner's position that one skilled in the art could not practice the invention without undue experimentation.

The present invention are drawn to a method for treating insulin resistance syndrome, diabetes, hyperlipidemia, fatty liver disease, cachexia, obesity, atherosclerosis and arteriosclerosis; reducing the symptoms of diabetes or the chances of developing a symptom of diabetes by administering to a mammalian subject an active agent as listed in claims 9, 17, 22, 30, 37.

The specification only discloses working examples of anti-diabetic effects for reducing blood glucose, triglycerides and fatty acids level by the administration of the compounds of claims 9, 17, 22, 30, 37 to diabetic mice.

It is generally recognized in the art that biological compounds often react unpredictably under different circumstances (*Nationwide Chem. Corp. v. Wright*, 458 F. supp. 828, 839, 192 USPQ 95, 105 (M.D. Fla. 1976); *Affd* 584 F.2d 714, 200 USPQ 257 (5th

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Cir. 1978); In re Fischer, 427 F.2d 833, 839, 166 USPQ 10, 24(CCPA 1970)). The relative skill of the artisan or the unpredictability of the pharmaceutical art is very high. Where the physiological activity of a chemical or biological compound is considered to be an unpredictable art (Note that in cases involving physiological activity such as the instant case, "the Scope of enablement obviously varies inversely with the degree of unpredictability of the factors involved" (See In re Fischer, 427 F.2d 833, 839, 166 USPQ 10, 24(CCPA 1970))), the skilled artisan would have not known how to extrapolate the results provided in the instant specification to the larger and varied genus of treatment of all of the disorders including insulin resistance syndrome, diabetes, hyperlipidemia, fatty liver disease, cachexia, obesity, atherosclerosis and arteriosclerosis.

For example, cachexia is characterized by progressive weakness, dramatic weight loss and wasting and is a common condition arising in many human cancer patients (Tisdale et al., US Patent 5,219,579, issued Jun. 15, 1993, column 1, lines 26-28). The specification of the instant application has not provided guidance, working example or mechanisms of action for the treatment of cachexia using the compounds listed in claims 9, 17, 22, 30, 37.

The examiner acknowledges that the Office does not require the presence of working examples to be present in the disclosure of the invention (see MPEP 2164.02). However, given the highly unpredictable state of the art and furthermore, given that the applicant does not provide sufficient guidance or direction as to how to make and use the full scope of the

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instant claimed invention without undue amount of experimentation, the Office would require appropriate disclosure, in the way of scientifically sound reasoning or the way of concrete examples, as to why the data shown is a reasonably representative and objective showing such that it was commensurate in scope with and, thus, adequately enables, the use of these compounds for the full scope of the presently claimed subject matter. In the absence of such guidance and evidence or reasoning, the specification fails to provide an enabling disclosure.

11. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

12. Claims 6-13 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are rendered indefinite by the phrase "administering to the subject an amount of..." The phrase "amount" is indefinite where the claim fails to state the function that is to be rendered effective.

13. Claims 34-41 rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: the method steps needed to treat a mammalian subject with the conditions listed in these claims.

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14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deborah D. Carr whose telephone number is 571-272-0637.

The examiner can normally be reached on Monday-Friday 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler can be reached on 571-272-0871. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


DEBORAH D. CARR
PRIMARY EXAMINER

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